

Applic. No. 10/054,439
Amdt. dated November 12, 2003
Reply to Office action of August 11, 2003

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-7 remain in the application. Claims 1 and 7 have been amended.

In item 2 on page 2 of the Office action, claims 1, 2, and 7 have been rejected as being fully anticipated by Gelinas (U.S. Patent No. 5,186,103) under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found on page 7, lines 5-6 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 7 call for, *inter alia*:

a mounting support for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable.

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The Gelinas reference discloses a cylinder (11) for transporting a web W (column 4, line 61 through column 5, line 8, and column 5, lines 15-26).

The reference does not show a mounting support for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable as recited in claims 1 and 7 of the instant application. The Gelinas reference discloses a cylinder for transporting a web W. This is contrary to the invention of the instant application as claimed, in which a mounting support is provided for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable.

In item 4 on page 3 of the Office action, claims 1-7 have been rejected as being obvious over Stein (U.S Patent No. 5,983,795) in view of Gelinas (U.S Patent No. 5,186,103) under 35 U.S.C. § 103.

It is noted that the corporate assignee of the Stein reference is also the assignee of the instant application. Therefore, applicants are very familiar with the reference.

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Applicants respectfully disagree with the Examiner's comments on page 4 of the Office action, that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Stein to have the adjusting device as taught by Gelinas, in order to accurately and efficiently transport printing materials of varying thicknesses. Support for Applicants' position is given below.

The transport of a web as disclosed in Gelinas requires completely different machine requirements than the transport of a sheet as disclosed in Stein. For example the gripper systems (9) disclosed in Stein for transporting a sheet (column 2, line 56) are not at all suitable for transporting a web W as disclosed in Gelinas. Furthermore, the horizontal path required in Gelinas (column 5, line 5) is completely unsuitable for transporting a sheet as disclosed in Stein. The above-given examples clarify that sheet transport and web transport are two completely different machine requirements. A person of ordinary skill in the art that deals with a problem in one field, i.e. sheet transport in the instant application would not search for solutions for the problem pertaining to sheet transport in another field, i.e. web transport. Therefore, a person of ordinary skill in the art would not use the teaching of Gelinas to modify Stein.

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Furthermore, the following is another reason why a person of ordinary skill in the art would be kept from using the teaching of Stein to position a sheet-transport cylinder (6) as disclosed in claim 1 of the instant application. A person of ordinary skill in the art knows that the sheet transport cylinder (6) disclosed in Stein has a non-illustrated gripper system, which cooperates with the illustrated gripper system (9) of the adjacent cylinder (7) during the transfer of a sheet from the sheet transport cylinder (6) to the adjacent cylinder (7). Furthermore, a person of ordinary skill in the art knows that an adjustment of the sheet transport cylinder (6) would cause the closing times of its gripper systems (gripper closing times) to be corrupted. Such an adjustment of the sheet transport cylinder (6) in Stein would disrupt the cooperation between the gripper systems of cylinder (6) and the gripper systems (9) of the downstream cylinder (7). Therefore, a person of ordinary skill in the art would not consider using the teaching of Gelinas to include an adjustment of the sheet transport cylinder (6) of Stein.

Only the applicants have found a solution for the problem pertaining to the gripper closing times (page 11, lines 1-23 of the specification).

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It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Stein to incorporate the

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features of Gelinas, and there is no teaching or suggestion in Gelinas to incorporate the features of Stein.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Stein or Gelinas or to combine Stein's and Gelinas's teachings to arrive at the claimed present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Stein or Gelinas or from knowledge available to those skilled in the art.

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Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Since claim 1 is believed to be allowable, dependent claims 2-6 are believed to be allowable as well.

Even though claim 4 is believed to be allowable, further discussion of claim 4 is given below.

As recited in claim 4 of the instant application, the adjustable sheet transport cylinder is disposed between another sheet transport cylinder and an impression cylinder. Therefore, at least one of the cylinders that the adjustable cylinder is disposed between is an impression cylinder. However, in Gelinas, the adjustable cylinder (11) is not disposed between two cylinders, and in fact the adjustable

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cylinder (11) in Gelinas is itself an impression cylinder.

These circumstances teach away from the present invention as recited in claim 4 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 7. Claims 1 and 7 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-7 are solicited.

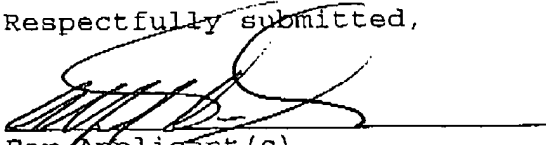
In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &
Greenberg P.A., No. 12-1099.

Respectfully submitted,


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